

DESIGNS BILL 2020
(BILL NO. 47 OF 2020)

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BILL NO. 47 OF 2020**A BILL**

FOR AN ACT TO PROVIDE FOR THE REGISTRATION OF DESIGNS IN FIJI
AND FOR RELATED MATTERS

ENACTED by the Parliament of Fiji—

PART 1—PRELIMINARY*Short title and commencement*

1.—(1) This Act may be cited as the Designs Act 2020.

(2) This Act comes into force on a date or dates appointed by the Minister by notice in the Gazette.

Interpretation

2.—(1) In this Act, unless the context otherwise requires—

“article” means any article of manufacture and includes any part of an article if that part is made and sold separately;

“assignee” includes the personal representative of a deceased assignee, and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person;

“Commissioner” means the Commissioner of Designs;

“convention country” means a country which is a party to a multilateral treaty relating to industrial designs to which Fiji is also a party;

“court” means the High Court of Fiji;

“design” means features of shape, configuration, pattern, or ornament applied to an article by any industrial process or means, being features which in the finished article give the article its overall appearance but does not include a method or principle of construction or features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform;

“Government department” means a department of the civil service, under a ministry;

“Minister” means the Minister responsible for designs;

“Ministry” means the Ministry responsible for designs;

“owner” has the meaning assigned to it by section 8;

“register” means the register kept under section 27;

“registered owner” means the person or persons for the time being entered in the register as owner of the design; and

“set of articles” means a number of articles of the same general character ordinarily on sale or intended to be used together, to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied.

(2) Any reference in this Act to an article in respect of which a design is registered is, in the case of a design registered in respect of a set of articles, to be construed as a reference to any article of that set.

(3) Any question arising under this Act as to whether a number of articles constitute a set of articles must be determined by the Commissioner, and notwithstanding anything in this Act any determination of the Commissioner under this subsection is final.

(4) For the purposes of sections 23(1) and 25(1), the expression “personal representative”, in relation to a deceased person, includes the legal representative of the deceased person appointed in any country outside Fiji.

(5) In the case of an entity that is a convention country but is not a state, part of a state, or a territory for whose international relations a state is responsible—

(a) a reference in this Act to—

(i) application for protection in a country; or

- (ii) application for protection in respect of a country, must be read as a reference to application for protection under the rules of the entity;
- (b) a reference in this Act to the law of a convention country must be read as a reference to the rules of the entity; and
- (c) a reference in this Act to the Government of a convention country must be read as a reference to the governing body of the entity.

Act binds the State

3. This Act binds the State.

Commissioner of Designs

4. The Solicitor-General is, for the purposes of this Act, to perform the functions and exercise the powers of the Commissioner of Designs.

Commissioner may delegate

5.—(1) The Commissioner may delegate to any person any of the Commissioner's functions, duties and powers except the power of delegation.

(2) A delegation—

- (a) must be in writing;
- (b) may be made subject to any restrictions and conditions that the Commissioner thinks fit;
- (c) is revocable at any time, in writing; and
- (d) does not prevent the performance or exercise of a function, duty or power by the Commissioner.

No liability of Commissioner and others

6. The Commissioner or any other person acting on behalf of the Commissioner is not liable for any act or omission done in the performance or intended performance of the Commissioner's functions or duties or the exercise or intended exercise of the Commissioner's powers under this Act if the Commissioner or other person acted—

- (a) in good faith;
- (b) in a reasonable manner; and
- (c) in the reasonably held belief that the prerequisites for the performance of any function or duty or the exercise of any power had been satisfied.

PART 2—REGISTRABLE DESIGNS AND PROCEEDINGS FOR REGISTRATION

Designs registrable under the Act

7.—(1) Subject to this section, a design may, on application made by the person claiming to be the owner, be registered under this Act in respect of any article or set of articles specified in the application.

(2) Subject to this Act, a design must not be registered under subsection (1) unless the design is new or original.

(3) For the purpose of subsection (2), if a design in respect of any article is the same as a design which before the date of the application for registration has been registered, disclosed or published in Fiji in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in the trade, the design must not be registered under subsection (1).

Ownership of designs

8.—(1) Subject to subsection (2), the author of a design must be treated for the purposes of this Act as the owner of the design, provided that where the design is executed by the author for another person for good consideration, that other person must be treated for the purposes of this Act as the owner.

(2) Where a design, or the right to apply a design to any article, becomes vested, whether by assignment, transmission, or operation of law, in any person other than the original owner, either alone or jointly with the original owner, that other person, or, as the case may be, the original owner and that other person, must be treated for the purposes of this Act as the owner or owners of the design or as the owner or owners of the design in relation to that article.

Proceedings for registration

9.—(1) An application for the registration of a design must be—

- (a) made in the prescribed form; and
- (b) be filed with the Commissioner in the prescribed manner.

(2) For the purpose of determining whether a design is new or original, the Commissioner may conduct such searches as the Commissioner thinks fit.

(3) The Commissioner may—

- (a) refuse any application for the registration of a design; or
- (b) register the design without modification or subject to such modifications,

as the Commissioner thinks fit.

(4) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed is deemed to be abandoned.

(5) Except as otherwise expressly provided by this Act, a design when registered must be registered as of the date on which the application for registration was made, or such other date whether earlier or later than that date as the Commissioner may in any particular case direct, provided that no proceedings are to be taken in respect of any infringement committed before the date on which the certificate of registration of the design under this Act is issued.

(6) A decision of the Commissioner under subsection (3) may be appealed to the court.

Registration of same design in respect of other articles etc.

10.—(1) Where the registered owner of a design registered in respect of any article makes an application—

- (a) for registration, in respect of one or more other articles, of the registered design; or
- (b) for registration, in respect of the same or one or more other articles, of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the registered design,

the application must not be refused and the registration made on that application must not be invalidated by reason only of the previous registration or publication of the registered design.

(2) Where any person makes an application for the registration of a design in respect of any article and either—

- (a) that design has been previously registered by another person in respect of some other article; or
- (b) the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity of the registered design,

then, if at any time while the application is pending the applicant becomes the registered owner of the design previously registered, subsection (1) applies as if at the time of making the application, the applicant had been the registered owner of that design.

Provisions for ensuring secrecy in respect of designs relevant for defence purposes

11.—(1) Where an application for the registration of a design has been made, and it appears to the Commissioner that the design is one of a class notified to the Commissioner by the Minister responsible for defence as relevant for defence purposes, or is in the opinion of the Commissioner likely to be valuable for defence purposes, the Commissioner may give directions to prohibit or restrict the publication of information with respect to the design, or the communication of such information to any person or class of persons specified in the directions.

(2) Where the Commissioner gives any directions under subsection (1), the Commissioner must give notice of the application and the directions to the Minister responsible for defence, and on notification—

- (a) the Minister responsible for defence must, on receipt of the notice, consider whether the publication of the design would be prejudicial to the defence of Fiji, and, unless a notice under paragraph (c) has previously been given by the Minister responsible for defence to the Commissioner, must reconsider that question before the expiration of 9 months from the date of filing of the application for the registration of the design and at least once in every subsequent year;

- (b) the Minister responsible for defence may, at any time after the design has been registered or, with the consent of the applicant, at any time before the design has been registered, inspect the representation or specimen of the design;
- (c) if on consideration of the design at any time it appears to the Minister responsible for defence that the publication of the design would not, or would no longer, be prejudicial to the defence of Fiji, the Minister responsible for defence must give notice to the Commissioner to that effect;
- (d) on the receipt of any such notice the Commissioner must revoke the directions and may, subject to such conditions, if any, as the Commissioner thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application or registration, whether or not that time has previously expired.

(4) A person resident in Fiji must not, except under the authority of a written permit granted by or on behalf of the Commissioner, make or cause to be made any application outside Fiji for the registration of a design of any class prescribed for the purposes of this subsection unless—

- (a) an application for registration of the same or substantially the same design has been made in Fiji not less than 6 weeks before the application outside Fiji; and
- (b) either no directions have been given under subsection (1) in relation to the application in Fiji or all such directions have been revoked,

provided that this subsection does not apply in relation to a design for which an application for protection has first been filed in a country outside Fiji by a person resident outside Fiji.

Provisions as to confidential disclosure etc.

12.—(1) An application for the registration of a design must not be refused and the registration of a design must not be invalidated, by reason only of—

- (a) the disclosure of the design by the owner to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design;
- (b) the disclosure of the design in breach of good faith by any person other than the owner of the design; or
- (c) in the case of a new or original textile design intended for registration, the acceptance of a first and confidential order for goods bearing the design.

(2) An application for the registration of a design must not be refused and the registration of a design must not be invalidated by reason only—

- (a) that a representation of the design, or any article to which the design has been applied, has been displayed or disclosed, with the consent of the

owner of the design, at an international or industrial exhibition declared as such by the Commissioner by notice in the Gazette, whether the exhibition is held in Fiji or elsewhere;

- (b) that after any such display or disclosure under paragraph (a), and during the period of the exhibition, a representation of the design or article has been displayed by any person without the consent of the owner; or
- (c) that a representation of the design has been published in consequence of any such display or disclosure under paragraph (a),

if the application for the registration of the design is made not later than 6 months after the date of the opening of the exhibition.

(3) An application for the registration of a design must not be refused and the registration of a design must not be invalidated by reason only of the communication of the design by the owner of the design to a Government department or to any person authorised by a Government department to consider the merits of the design, or of anything done in consequence of such a communication.

PART 3—EFFECT OF REGISTRATION

Right given by registration

13.—(1) The registration of a design under this Act gives to the registered owner the exclusive right in the registered design in Fiji to make or import for sale or for use for the purposes of any trade or business, or to sell, hire, or offer for sale or hire, any article in respect of which the design is registered, being an article to which the registered design or a design not substantially different from the registered design has been applied, and to make anything to enable any such article to be made, whether in Fiji or elsewhere.

(2) Subject to this Act and section 4(3) of the State Proceedings Act 1951, the registration of a design has the same effect against the State as it has against a person.

Term of registration

14.—(1) The term of registration of a design, subject to this Act, subsists for a period of 5 years from the date of registration.

(2) Subject to sections 46 to 51, the Commissioner must extend the period for a second period of 5 years from the expiration of the original period, if an application for extension for the second period is made in the prescribed manner and the prescribed fee is also paid before the expiration of the original period, or if such application is made and the fee is paid within such further period not exceeding 6 months as may be specified in a request to the Commissioner and accompanied by the prescribed additional fee.

Exemption of innocent infringer from liability for damages etc.

15.—(1) In proceedings for the infringement of a right in a registered design, damages or account of profits must not be awarded against a defendant who proves that at the date of the infringement, the defendant was not aware and had no reasonable ground for believing that the design was registered in Fiji, and a person is not deemed to have been

aware or to have had any reasonable ground for so believing by reason only of the marking of an article with the word “registered” or any abbreviation of the word “registered”, or any word or words expressing or implying that the design applied to the article has been registered, unless the word or words are accompanied by the words “Republic of Fiji”, “Fiji”, “Fiji Islands”, “Fiji islands” or the letters “FJ” and by the number of the design.

(2) Nothing in this section affects the power of the court to grant an injunction in any proceedings for infringement of the right in a registered design.

Compulsory licence in respect of registered design

16.—(1) At any time after a design has been registered, any person interested may apply to the Commissioner for the grant of a compulsory licence in respect of the design on the ground that the design is not applied in Fiji by any industrial process or means to the article in respect of which it is registered to such an extent as is reasonable in the circumstances of the case, and the Commissioner may make such order on the application as the Commissioner thinks fit.

(2) An order for the grant of a licence, without prejudice to any other method of enforcement, has effect as if it were a deed executed by the registered owner and all other necessary parties, granting a licence in accordance with the order.

(3) An order of the Commissioner under this section must not be inconsistent with any treaty, convention, arrangement or engagement applying to Fiji and any convention country.

(4) An order of the Commissioner under this section may be appealed to the court.

Cancellation of registration

17.—(1) The Commissioner may, on a request made in the prescribed manner by the registered owner, cancel the registration of a design.

(2) At any time after a design has been registered, any person interested may apply to the Commissioner for the cancellation of the registration of the design on the ground that the design was not, at the date of the registration of the design, new or original, or on any other ground on which the Commissioner could have refused to register the design, and the Commissioner may make such order on the application as the Commissioner thinks fit.

(3) An order of the Commissioner under subsection (2) may be appealed to the court.

Use of registered designs for services of the State

18.—(1) Notwithstanding anything in this Act, any Government department, and any person authorised in writing by a Government department, may use any registered design for the services of the State in accordance with this section.

(2) If the design has, before the date of registration of the design, been duly recorded by or applied by or on behalf of a Government department otherwise than in consequence of the communication of the design directly or indirectly by the registered owner or any person from whom the registered owner derives title, any use of the design by virtue of this section may be made free of any royalty or other payment to the registered owner.

(3) If the design has not been so recorded or applied, any use of the design made by virtue of this section at any time after the date of registration of the design, or in consequence of any such communication, must be made on such terms as may be agreed on, either before or after the use, between the Government department and the registered owner with the approval of the Minister responsible for finance, or as may in default of agreement be determined by the court on a reference under section 20.

(4) The authority of a Government department in respect of a design may be given under this section either before or after the design is registered and either before or after the acts in respect of which the authority is given are done, and may be given to any person whether or not the person is authorised directly or indirectly by the registered owner to use the design.

(5) Where any use of a design is made by or with the authority of a Government department under this section then, unless it appears to the Government department that it would be contrary to the public interest so to do, the Government department must notify the registered owner as soon as practicable after the use has begun, and furnish the registered owner with such information as to the extent of the use as the registered owner may from time to time require.

(6) For the purposes of this section and section 19, any use of a design for the supply to the government of any country outside Fiji, pursuant to any agreement or arrangement between the Government of Fiji and the government of that country, of articles required for the defence of that country is deemed to be a use of the design for the services of the State, and the power of a Government department or a person authorised by a Government department under this section to use a design includes the power to—

- (a) sell such articles to the government of any country pursuant to any such agreement or arrangement; and
- (b) sell to any person any articles made in the exercise of the powers conferred by this section which are no longer required for the purpose for which they were made.

(7) The purchaser of any articles sold in the exercise of powers conferred by this section, and any person claiming through the purchaser, has the power to deal with them in the same manner as if the rights in the registered design were held on behalf of the State.

Rights of third parties in respect of State use

19.—(1) In relation to any use of a registered design, or a design in respect of which an application for registration is pending, made for the services of the State by—

- (a) a Government department or a person authorised by a Government department under section 18; or
- (b) the registered owner or applicant for registration to the order of a Government department,

the provisions of any licence, assignment, or agreement made, whether before or after the commencement of this Act, between the registered owner or applicant for registration or any person who derives title from the registered owner or from whom the registered owner derives title and any person other than a Government department is of no effect so far as those provisions restrict or regulate the use of the design, or any model, document, or information relating to, or provide for the making of payments in respect of any such use, or calculated by reference to, and the reproduction or publication of any model or document in connection with the said use does not constitute an infringement of any right in the registered design subsisting in the model or document.

(2) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the use of the design is in force under the registered design, then—

- (a) in relation to any use of the design which, but for this section and section 18, would constitute an infringement of the rights of the licensee, section 18(3) has effect as if for the reference to the registered owner there were substituted a reference to the licensee; and
- (b) in relation to any use of the design by the licensee by virtue of an authority given under section 18, that section has effect as if section 18(3) were omitted.

(3) Subject to subsection (2), where the registered design or the right to apply for or obtain registration of the design has been assigned to the registered owner in consideration of royalties or other benefits determined by reference to the use of the design, then—

- (a) in relation to any use of the design by virtue of section 18, section 18(3) has effect as if the reference to the registered owner included a reference to the assignor, and any sum payable by virtue of section 18(3) is to be divided between the registered owner and the assignor in such proportion as may be agreed on between them or as may in default of agreement be determined by the court on a reference under section 20; and
- (b) in relation to any use of the design made for the services of the State by the registered owner to the order of a Government department, section 18(3) has effect as if that use were made by virtue of an authority given under section 18(3).

(4) Where, under section 18(3), payments are required to be made by a Government department to a registered owner in respect of any use of a design, any person being the holder of an exclusive licence under the registered design, not being such a licence under subsection (2), authorising the person to make that use of the design is entitled to recover from the registered owner such part, if any, of those payments as may be agreed on between that person and the registered owner, or as may in default of agreement be determined by the court under section 20 to be just having regard to any expenditure incurred by that person—

- (a) in developing the said design; or

- (b) in making payments to the registered owner, other than royalties or other payments determined by reference to the use of the design, in consideration of the licence,

and if, at any time before the amount of any such payment has been agreed on between the Government department and the registered owner, that person gives notice in writing of the person's interest to the department, any agreement as to the amount of that payment is of no effect unless it is made with the registered owner's consent.

(5) In this section, "exclusive licence" means a licence from the registered owner which confers on the licensee, or on the licensee and persons authorised by the registered owner, to the exclusion of all other persons, including the registered owner, any right in respect of the registered design.

Reference of disputes as to State use

20.—(1) Any dispute as to the exercise by a Government department or a person authorised by a Government department of the powers conferred by section 18, or as to terms for the use of a design for the services of the State, or as to the right of any person to receive any part of a payment made pursuant to section 18(3), may be referred to the court by either party to the dispute in such manner as may be prescribed by rules of court.

(2) In any proceedings under this section to which a Government department is a party, the Government department may—

- (a) if the registered owner is a party to the proceedings, apply for cancellation of the registration of the design on any ground on which the registration of a design may be cancelled on an application to the court under section 31; and
- (b) in any case, put in issue the validity of the registration of the design without applying for its cancellation.

(3) If in such proceedings, any question arises whether a design has been recorded or applied as mentioned in section 18, and the disclosure of any document recording the design, or of any evidence of the application thereof, would in the opinion of the Government department be prejudicial to the public interest, the disclosure may be made confidentially to counsel for the other party or to an independent expert mutually agreed on.

(4) In determining under this section any dispute between a Government department and any person as to terms for the use of a design for the services of the State, the court must have regard to any benefit or compensation which that person or any person from whom the person derives title may have received, or may be entitled to receive, directly or indirectly from any Government department in respect of the design in question.

(5) In any proceedings under this section the court may at any time order the whole proceedings or any question or issue of fact arising to be referred to a special or official referee or an arbitrator on such terms as the court may direct, and references to the court in subsections (1) to (4) must be construed accordingly.

Special provisions as to State use during emergency

21.—(1) During any period of emergency, the powers exercisable in relation to a design by a Government department, or a person authorised by a Government department under section 18, includes the power to use the design for any purpose which appears to the Government department necessary or expedient—

- (a) to maintain supplies and services essential to the life of the community;
- (b) to secure a sufficiency of supplies and services essential to the wellbeing of the community;
- (c) to promote the productivity of industry, commerce and agriculture;
- (d) to foster and direct exports and reducing imports, or imports of any classes, from all or any country and for redressing the balance of trade; or
- (e) generally to ensure that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community,

and any reference in sections 18 to 20 to the services of the State is construed as including a reference to the purposes.

(2) In this section, “period of emergency” means any period beginning on such date as may be declared by the Minister by notice in the Gazette to be the commencement, and ending on such date as may be so declared to be the termination, of a period of emergency.

PART 4—INTERNATIONAL ARRANGEMENTS

Convention countries

22. For the purpose of giving effect to any international agreement or arrangement to which Fiji is a party or that applies to Fiji, the Minister may by notice in the Gazette declare that any entity specified in the notice that is a party to the agreement or arrangement or to which the agreement or arrangement applies, whether a state, part of a state, a territory for whose international relations a state is responsible, a political union, an international organisation, or any other entity, is, for the purposes of all or any of the provisions of this Act, a convention country.

Registration of design where application for protection in convention country has been made

23.—(1) An application for the registration of a design in respect of which protection has been applied for in a convention country may be made in accordance with this Act by the person by whom the application for protection was made or his or her personal representative or assignee, provided that no application is made by virtue of this section after the expiration of 6 months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application.

(2) A design registered on an application made by virtue of this section must be registered as of the date of the application for protection in the convention country, or where more than one such application for protection has been made, the date of the

first application, provided that no proceedings are taken in respect of any infringement committed before the date on which the certificate of registration of the design under this Act is issued.

(3) An application for the registration of a design made by virtue of this section must not be refused, and the registration of a design on such an application is not invalidated, by reason only of the registration or publication of the design in Fiji during the period specified in the proviso to subsection (1) as that within which the application for registration may be made.

(4) Where a person has applied for protection for a design by an application which—

- (a) in accordance with the terms of a treaty subsisting between 2 or more convention countries, is equivalent to an application duly made in any one of those convention countries; or
- (b) in accordance with the law of any convention country, is equivalent to an application duly made in that convention country,

the person is deemed for the purposes of this section, to have applied in that convention country.

(5) For the purposes of this section, where more than one application for protection in a convention country has been made, the first application may be disregarded and the second application must be substituted for the first application where—

- (a) the first application was made in or in respect of the same convention country and by the same applicant as the second application;
- (b) not later than the date of filing of the second application, the first application was unconditionally withdrawn, abandoned, or refused;
- (c) the first application had not been made available to the public in Fiji or elsewhere before its unconditional withdrawal, abandonment, or refusal;
- (d) no rights remain outstanding in respect of the first application; and
- (e) the first application has not served as a basis for claiming a right of priority in relation to another application in any country.

Extension of time for applications under section 23 in certain cases

24.—(1) If the Minister is satisfied that provision substantially equivalent to the provision to be made by or under this section has been or will be made under the law of any convention country, he or she may make regulations empowering the Commissioner to extend the time for making an application under section 23(1) for registration of a design in respect of which protection has been applied for in that country in any case where the period specified in the proviso to section 23(1) expires during a period prescribed by the regulations.

(2) Regulations made under this section—

- (a) may, where any agreement or arrangement has been made between the Government of Fiji and the Government of a convention country for the supply or mutual exchange of information or articles, provide, either generally or in any class of case specified in the regulations, that an extension of time must not be granted under this section unless the design has been communicated in accordance with the agreement or arrangement;
- (b) may, either generally or in any class of case specified in the regulations, fix the maximum extension which may be granted under this section;
- (c) may prescribe or allow any special procedure in connection with applications made by virtue of this section;
- (d) may empower the Commissioner to extend, in relation to an application made by virtue of this section, the time limited by or under the foregoing provisions of this Act for doing any act, subject to such conditions, if any, as may be imposed by or under the regulations;
- (e) may provide for securing that the rights conferred by registration on an application made by virtue of this section are subject to such restrictions or conditions as may be specified by or under the regulations and in particular to restrictions and conditions for the protection of persons who, otherwise than as the result of a communication made in accordance with such an agreement or arrangement as is mentioned in paragraph (a), and before the date of the application in question or such later date as may be allowed by the regulations, may have imported or made articles to which the design is applied or may have made an application for the registration of the design.

Protection of designs communicated under arrangements with other countries

25.—(1) Subject to this section, regulations may be made under this Act for securing that, where a design has been communicated in accordance with an agreement or arrangement made between the Government of Fiji and the Government of any other country for the supply or mutual exchange of information or articles—

- (a) an application for the registration of the design made by the person from whom the design was communicated, or his or her personal representative or assignee, must not be prejudiced, and the registration of the design pursuant to such an application not be invalidated, by reason only that the design has been so communicated or that in consequence of such communication—
 - (i) the design has been published or applied; or
 - (ii) an application for the registration of the design has been made by any other person, or the design has been registered on such an application;

- (b) any application for the registration of a design made in consequence of such a communication may be refused and any registration of a design made on such an application may be cancelled.

(2) Regulations made under subsection (1) may provide that the publication or application of a design, or the making of any application for registration thereof, must, in such circumstances and subject to such conditions or exceptions as may be prescribed by the regulations be presumed to have been in consequence of such a communication under subsection (1).

(3) The power to make regulations under this section, so far as it is exercisable for the benefit of persons from whom designs have been communicated to the Government of Fiji by the Government of any other country, must only be exercised if and to the extent that the Minister is satisfied that substantially equivalent provision has been or will be made under the law of that country for the benefit of persons from whom designs have been communicated by the Government of Fiji to the Government of that country.

(4) References in subsection (3) to the communication of a design to or by the Government of Fiji or the Government of any other country is to be construed as including references to the communication of the design by or to any person authorised in that behalf by the Government in question.

Regulations under section 24 or 25

26. Any regulations made under section 24 or 25, and any order made, direction given, or other action taken under the regulations by the Commissioner, may be made, given, or taken so as to have effect as respects things done or omitted to be done on or after such date, whether before or after the coming into operation of the regulations or of this Act, as may be specified in the regulations.

PART 5—REGISTER OF DESIGNS

Register of designs

27.—(1) The Commissioner must ensure that a register of designs registered in Fiji is kept and maintained.

(2) The register must contain the names and addresses of registered owners, notices of assignments and transmissions of registered designs, and such other matters as may be prescribed or as the Commissioner thinks fit.

(3) The register may be kept in any manner that the Commissioner thinks fit, including, either wholly or partly, by means of a device or facility—

- (a) that records or stores information electronically or by other means; and
- (b) that permits the information so recorded or stored to be readily inspected or reproduced in usable form.

(4) Subject to this Act, the register must, at all convenient times, be open to inspection by the public, and certified copies of any entry in the register must be given to any person requiring them on payment of the prescribed fee.

(5) The register is *prima facie* evidence of any matters required or authorised by this Act to be entered therein.

Certificate of registration

28.—(1) The Commissioner must grant a certificate of registration in the prescribed form to the registered owner of a design when the design is registered.

(2) The Commissioner may, in a case where he or she is satisfied that the certificate of registration has been lost or destroyed, or in any other case in which he or she thinks it expedient, on application made to him or her in the prescribed manner and on payment of the prescribed fee, furnish a further certificate.

Registration of assignments etc.

29.—(1) Where any person becomes entitled by assignment, transmission, or operation of a law to a registered design or to a share in a registered design, or becomes entitled as mortgagee, licensee, or otherwise to any other interest in a registered design, the person must apply to the Commissioner in the prescribed manner for the registration of his or her title as owner or co-owner, or, as the case may be, of notice of his or her interest, in the register.

(2) Without prejudice to subsection (1), an application for the registration of the title of any person becoming entitled by assignment to a registered design or a share in a registered design, or becoming entitled by virtue of a mortgage, licence, or other instrument to any other interest in a registered design, may be made in the prescribed manner by the assignor, mortgagor, licensor, or other party to that instrument, as the case may be.

(3) Where application is made under this section for the registration of the title of any person, the Commissioner must, on proof of title to his or her satisfaction—

- (a) where that person is entitled to a registered design or a share in a registered design, register the person in the register as owner or co-owner of the design, and enter in that register particulars of the instrument or event by which the person derives title; or
- (b) where that person is entitled to any other interest in the registered design, enter in that register notice of his or her interest, with particulars of the instrument, if any, creating it.

(4) Subject to any rights vested in any other person of which notice is entered in the register, the person or persons registered as owner of a registered design have the power to assign, grant licences under, or otherwise deal with the design, and to give effectual receipts for any consideration for any such assignment, licence, or dealing, provided that any equities in respect of the design may be enforced in like manner as in respect of any other personal property.

(5) Except for the purposes of an application to correct the register under this Part, a document in respect of which no entry has been made in the register under subsection (3) must not be admitted in any court as evidence of the title of any person to a registered design or share of or interest in a registered design unless the court otherwise directs.

Application of Personal Property Securities Act 2017

30. Nothing in sections 27 to 29 affects the operation of the Personal Property Securities Act 2017.

Correction of register

31.—(1) The court may, on the application of any person aggrieved, order the register to be corrected by the making of any entry therein or the variation or deletion of any entry therein.

(2) In proceedings under this section, the court may determine any question which it may be necessary or expedient to decide in connection with the correction of the register.

(3) Notice of any application to the court under this section must be given in the prescribed manner to the Commissioner, who is entitled to appear and be heard on the application, and must appear if so directed by the court.

(4) Any order made by the court under this section must direct that notice of the order is to be served on the Commissioner in the prescribed manner; and the Commissioner must, on receipt of the notice, correct the register accordingly.

Commissioner may correct errors

32.—(1) Where a mistake exists on the register or in any document issued under this Act by reason of any error or omission on the part of the Commissioner, the Commissioner may, in accordance with this section, require the production of the document and correct the mistake.

(2) Before the Commissioner corrects a mistake on the register or in any document issued under this Act, the Commissioner must give—

(a) notice of his or her proposal to correct the mistake to a person who appears to him or her to be concerned; and

(b) the person an opportunity to be heard before making the correction.

(3) Where a mistake exists in the register, or in any application for the registration of a design or other document filed pursuant to such an application, or in any proceedings in connection with any design, by reason of an error or an omission on the part of the owner of the design or of the applicant for registration of the design or of any other person concerned, a correction may be made in accordance with this section on a request in writing by any person interested and payment of the prescribed fee.

(4) If it appears to the Commissioner that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons likely to be affected by the correction, the Commissioner must require notice of the nature of the proposed correction to be advertised in the prescribed manner.

(5) Within the prescribed time after any the advertisement, any person interested may give notice to the Commissioner of opposition to the request, and where any such notice of opposition is given the Commissioner must give notice thereof to the person by whom the request was made, and must give to him or her and to the opponent, an opportunity to be heard before the Commissioner decides the case.

(6) A decision of the Commissioner under this section may be appealed to the court.

Inspection of registered designs

33.—(1) Subject to this section and to any regulations made pursuant to section 10(2), the representation or specimen of a design registered under this Act must be open to inspection by the public on and after the day on which the certificate of registration is issued.

(2) In the case of a design registered in respect of an article of any class prescribed for the purposes of this subsection, any representation or specimen of the design filed pursuant to the application must not, until the expiration of such period after the day on which the certificate of registration is issued as may be prescribed in relation to articles of that class, be open to inspection by the public except by—

- (a) the registered owner;
- (b) a person authorised in writing by the registered owner; or
- (c) a person authorised by the Commissioner or by the court,

provided that where the Commissioner proposes to refuse an application for the registration of any other design on the ground that it is the same as or differs only in immaterial details or in features which are variants commonly used in the trade, the applicant is entitled to inspect the representation or specimen of the first mentioned design filed pursuant to the application for the registration of that design.

(3) In the case of a design registered in respect of an article of any class prescribed for the purposes of subsection (2), the representation or specimen of the design must not, during the period prescribed, be inspected by any person by virtue of this section except in the presence of the Commissioner or of a member of his or her staff acting under him or her, and except in the case of an inspection authorised by the proviso in subsection (2), the person making the inspection is not entitled to take a copy of the representation or specimen of the design or any part thereof.

(4) Where an application for the registration of a design has been abandoned or refused, neither the application for registration nor any representation or specimen of the design filed in pursuance thereof must at any time be open to inspection by the public or be published by the Commissioner.

(5) Nothing in this section prevents the Commissioner from publishing any of the following—

- (a) the date of filing of an application for the registration of a design;

- (b) the number of an application for the registration of a design; and
- (c) any details of an application for the registration of a design required to be in the application form.

Information as to registration of design

34. On the request of any person furnishing such information as may enable the Commissioner to identify the design, and on payment of the prescribed fee, the Commissioner must inform the person whether the design is registered, and, if so, in respect of what articles, and whether any extension of the period of registration of the design has been granted, and must state the date of registration and the name and address of the registered owner.

Evidence of entries, documents etc.

35.—(1) A certificate purporting to be signed by the Commissioner and certifying that any entry which he or she is authorised by or under this Act to make has or has not been made, or that any other thing which he or she is so authorised to do has or has not been done, is *prima facie* evidence of the matters so certified.

(2) A copy of, or an extract from, any entry in the register or of any document that is registered or otherwise kept by the Commissioner that purports to be certified as a true copy or extract by the Commissioner is admissible in evidence in legal proceedings as if it were the original.

PART 6—LEGAL PROCEEDINGS AND APPEALS

Certificate of contested validity of registration

36.—(1) If in any proceedings before the court, the validity of the registration of a design is contested, and it is found by the court that the design is validly registered, the court may certify that the validity of the registration of the design was contested in those proceedings.

(2) Where any such certificate has been granted, then, if in any subsequent proceedings before the court for infringement of the right in the registered design or for cancellation of the registration of the design a final order or judgment is made or given in favour of the registered owner, the registered owner is, unless the court otherwise directs, entitled to the registered owner's costs as between solicitor and client, provided that this subsection does not apply to the costs of any appeal in any such proceedings.

Remedy for groundless threats of infringement proceedings

37.—(1) Where any person, whether entitled to or interested in a registered design or an application for the registration of a design or not, by circulars, advertisements, or otherwise threatens any other person with proceedings for infringement of a right in a registered design, any person aggrieved thereby may bring an action against that person for any such relief as is mentioned in subsection (2).

(2) Unless in any action brought by virtue of this section, the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a right in a registered design the registration of which is not shown by the plaintiff to be invalid, the plaintiff is entitled to the following relief—

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as the plaintiff has sustained.

(3) For the avoidance of doubt, a mere notification that a design is registered does not constitute a threat of proceedings within the meaning of this section.

Appeals

38.—(1) Every appeal under this Act against a decision of the Commissioner must be made to the court.

(2) Notice of every such appeal must be filed in the court and served on the Commissioner within 28 days after the day on which the decision appealed against was given.

(3) In any such appeal, the court must have and may exercise the same discretionary powers as are conferred on the Commissioner.

(4) Except with the leave of the court or the Court of Appeal, no appeal lies from any decision of the Court on an appeal against a decision of the Commissioner.

PART 7—POWERS AND DUTIES OF COMMISSIONER

Exercise of discretionary powers of Commissioner

39. Without prejudice to any provision of this Act requiring the Commissioner to hear any party to proceedings, or to give to any such party an opportunity to be heard, the Commissioner must give to any applicant for registration of a design an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Commissioner by or under this Act.

Commissioner may grant extension of time

40.—(1) Where by this Act anything is required to be done within a prescribed time, and by reason of delay by the Commissioner the thing is not so done, the Commissioner may extend the time for the doing of the thing.

(2) No fees are payable in respect of any extension of time granted under this section.

(3) The powers conferred on the Commissioner by this section may be exercised notwithstanding that in any case the time limited may have expired.

Additional provisions for extending time limits

41.—(1) The Commissioner may extend the time prescribed in section 22(1) for the filing of an application under that section on such terms, if any, as the Commissioner thinks fit where he or she is satisfied that the circumstances warrant the extension.

(2) Notwithstanding subsection (1), the Commissioner must refuse to grant an extension of time under that subsection if in his or her opinion—

- (a) the applicant or the applicant’s agent has not allowed a reasonable margin of time for the delivery of any document relating to the matter in respect of which the application for the extension of time is made;
- (b) the applicant or the applicant’s agent has in any other way failed to act with due diligence and prudence in respect of such matter; or
- (c) there has been undue delay in bringing the application for the extension of time or in prosecuting the application.

(3) Every extension of time granted under this section must be published in the Gazette in the prescribed manner.

(4) Where an application is made for an extension of time under this section by an agent on behalf of any applicant, the Commissioner may as a condition of granting the application require that written confirmation that the application is authorised must be signed or executed by the applicant and lodged with the Commissioner within such time as the Commissioner specifies.

(5) Any extension of time under this section, and any requirement given or other action taken by the Commissioner under this section, may be granted, given, or taken so as to have effect in respect of things done or omitted to be done before the commencement of this section, as long as the application for the extension of time has been made before registration of the design in respect of which the application under this section has been made.

Costs and security for costs

42.—(1) The Commissioner may, in any proceedings before him or her under this Act, by order award to any party such costs as the Commissioner may consider reasonable, and direct how and by what parties they are to be paid, and any such order may be entered as a judgment of the court and, with the leave of the court, may be enforced accordingly.

(2) If any party by whom an application is made to the Commissioner for the cancellation of the registration of a design or for the grant of a licence in respect of a registered design or by whom notice of appeal is given from any decision of the Commissioner under this Act, does not reside or carry on business in Fiji, the Commissioner, or, in the case of appeal, the court, may require him or her to give security for the costs of the proceedings or appeal, and in default of such security being given may treat the application or appeal as abandoned.

Evidence before Commissioner

43.—(1) Subject to regulations made under this Act, the evidence to be given in any proceedings before the Commissioner under this Act may be given by affidavit or statutory declaration, but the Commissioner may if he or she thinks fit in any particular case, take oral evidence instead of or in addition to such evidence, and may allow any witness to be cross-examined on his or her affidavit or statutory declaration.

(2) Any such statutory declaration may, in the event of an appeal under this Act, be used before the court instead of evidence by affidavit, and where so used, has all the incidents and consequences of evidence by affidavit.

(3) Subject to regulations made under this Act, the Commissioner must in respect of requiring the attendance and the examination of witnesses on oath and the discovery and production of documents have the same powers as the Commissioner of Patents has in proceedings under the Patents Act 2020.

Recognition of agents

44. Where this Act requires any act to be done by or to any person in connection with a registered design or proposed registered design or any proceedings relating to the act to be done by or to any person in connection with a registered design or proposed registered design, the act may, unless otherwise prescribed, be done by or to an agent of that person duly authorised in the prescribed manner.

Commissioner may dispense with production of probate or letters of administration in certain cases

45.—(1) For the purposes of this section, unless the context otherwise requires—

“deceased owner” means a registered owner of any design who has died, whether before or after the commencement of this Act and includes any applicant for the registration of a design who has died before it is registered, whether before or after the commencement of this Act; and

“qualified person”, in relation to any deceased owner, means a person who satisfies the Commissioner—

- (a) that he or she has obtained or is entitled to obtain probate of the will of the deceased owner or letters of administration in his or her estate in the place where the deceased owner was domiciled at his or her death, or that he or she is the legal representative of the deceased owner in that place;
- (b) that probate of the will of the deceased owner or letters of administration in his or her estate have not been granted or resealed in Fiji;
- (c) that the interests of the creditors of the deceased owner, and of all persons beneficially interested under his or her will or on his or her intestacy, will be adequately safeguarded if the Commissioner registers the qualified person as the owner of the design.

(2) On application in the prescribed manner and payment of the prescribed fees, the Commissioner, in his or her discretion and without requiring the production of probate or letters of administration, may—

- (a) where the registered owner of any design has died, whether before or after the commencement of this Act, register any qualified person as the owner of the design;

(b) where an applicant for the registration of a design has died before the registration of the design, whether before or after the commencement of this Act, allow any qualified person to complete the application and may register that person as the owner of the design.

(3) Every qualified person who is registered under this section as the owner of a design holds the design subject to all existing interests and equities affecting it.

(4) Nothing in section 43 of the Succession, Probate and Administration Act 1970 is deemed to restrict the operation of this section.

PART 8—RESTORATION OF LAPSED REGISTRATION

Restoration of lapsed registration

46.—(1) This section applies if the period of right in a registered design has ended by reason of a failure to make an application under section 14(2) or to pay the prescribed fee under section 14(2), or both.

(2) The Commissioner may, on a request made in the prescribed manner and in accordance with sections 47 to 51, by order extend the period of registration of a design for a second period of 5 years as provided for in section 14(2) if the Commissioner is satisfied that the relevant failure to comply with section 14(2) was unintentional.

(3) A request for an order under this section must contain a statement that fully sets out the circumstances that led to the relevant failure to comply with section 14(2).

(4) The Commissioner may require the person who makes the request to provide any further evidence that the Commissioner thinks fit.

(5) An appeal to the court may be made from any decision of the Commissioner under this section or sections 47 to 51.

Persons who may make request for restoration

47.—(1) A request for an order under section 46 may be made by the person who was the registered owner or, if that person is deceased, by that person's personal representative.

(2) If there were 2 or more registered owners, the request for an order under section 46 may, with the leave of the Commissioner, be made by one or more of them without joining the others.

When request for restoration may be made

48.—(1) A request for an order under section 46 may only be made within the prescribed period.

(2) The Commissioner may extend the period within which a request may be made if the Commissioner is satisfied that there was no undue delay in making the request.

(3) The person who makes the request must, for the purposes of subsection (2), provide the Commissioner with a statement that fully sets out the circumstances that caused the delay and the reasons for the delay.

(4) The Commissioner may require that person to provide any further evidence that the Commissioner thinks fit.

Commissioner's consideration of whether prima facie case has been made out for restoration

49.—(1) The Commissioner must, after considering a request made in accordance with sections 46 to 48, give the person who made the request a reasonable opportunity to be heard if the Commissioner is not satisfied that a *prima facie* case has been made out for an order under section 46.

(2) The Commissioner must publish a request made in accordance with sections 46 to 48 in the Gazette if the Commissioner is satisfied that a *prima facie* case has been made out for an order under section 46.

Notice of opposition and reasonable opportunity to be heard

50.—(1) Any person may, within the prescribed period, give notice to the Commissioner of opposition to an order being made under section 46 on either or both of the following grounds—

- (a) that the relevant failure to comply with section 14(2) was not unintentional;
- (b) if the period within which a request for an order under section 46 may be made is extended under section 48, that the delay in making the request was undue.

(2) The Commissioner must notify the person who made the request if a person has given notice under subsection (1) and provide the person who made the request with a copy of that notice.

(3) The Commissioner must give the person who made the request and the person who has given notice under subsection (1) a reasonable opportunity to be heard before the Commissioner decides the case.

Order to be made on payment of unpaid fees

51.—(1) If the Commissioner has published a request under section 49, he or she must make an order under section 46 in accordance with the request after the prescribed period for giving notice of opposition if—

- (a) all unpaid prescribed fees are paid;
- (b) all other prescribed additional penalties, if any, are paid; and
- (c) either—
 - (i) no notice of opposition is given within the prescribed period; or
 - (ii) in the case of a notice of opposition having been given within the prescribed period, the decision of the Commissioner is in favour of the person who made the request.

(2) An order for the extension of registration of a design—

- (a) may be made subject to a condition requiring the registration of any matter if the provisions of this Act concerning entries in the register have not been complied with;
- (b) must contain, or be subject to, the provisions prescribed for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the design between the date when the period ended and the date on which the request is published under section 49; and
- (c) may be made subject to any other conditions that the Commissioner thinks fit.

(3) If any condition of an order under this section is not complied with by the registered owner, the Commissioner may revoke the order and give any directions consequential on the revocation that the Commissioner thinks fit.

(4) The Commissioner must, before the Commissioner makes a decision under subsection (3), give the registered owner a reasonable opportunity to be heard.

Request for restoration of abandoned design application

52.—(1) This section applies if an application for the registration of a design is abandoned under section 9(4).

(2) The applicant may make a request to the Commissioner in the prescribed manner for an order to restore the application and to extend the period for complying with the requirements imposed on the applicant by or under this Act to a date that is specified in the order.

(3) Every request for an order must contain a statement that fully sets out the circumstances that led to the abandonment under section 9(4).

(4) The Commissioner must, after considering a request, give the person who made the request a reasonable opportunity to be heard if the Commissioner is not satisfied that the default or neglect on the part of the applicant that resulted in the application being abandoned under section 9(4) was unintentional.

(5) The Commissioner must publish the request in the Gazette if the Commissioner is satisfied that the default or neglect on the part of the applicant that resulted in the application being abandoned under section 9(4) was unintentional.

(6) A decision of the Commissioner under this section or sections 53 to 55.

When request for restoration of application may be made

53.—(1) A request under section 51 may only be made within the prescribed period.

(2) The Commissioner may extend the period within which a request may be made if the Commissioner is satisfied that there was no undue delay in making the request.

(3) The applicant must, for the purposes of subsection (2), provide the Commissioner with a statement that fully sets out the circumstances that caused the delay and the reasons for the delay.

(4) The Commissioner may require the applicant to provide any further evidence that the Commissioner thinks fit.

Notice of opposition

54.—(1) Any person may, within the prescribed period, give notice to the Commissioner of opposition to an order being made under section 56 on either or both of the following grounds—

- (a) that the default or neglect on the part of the applicant that resulted in the application being abandoned under section 9(4) was not unintentional;
- (b) if the period within which a request under section 52 may be made is extended under section 53, that the delay in making the request was undue.

(2) The Commissioner must notify the applicant if a person has given notice under subsection (1) and provide the applicant with a copy of that notice.

(3) The Commissioner must give the applicant and the person who has given notice under subsection (1) a reasonable opportunity to be heard before the Commissioner decides the case.

Commissioner to determine matter

55.—(1) The Commissioner must, after the expiry of the prescribed period for giving notice of opposition under section 54—

- (a) by order restore the application and extend the period for complying with the requirements imposed on the applicant by or under this Act to a period that is specified in the order if the Commissioner is satisfied that—
 - (i) the default or neglect on the part of the applicant that resulted in the application being abandoned under section 9(4) was unintentional; and
 - (ii) if the period within which a request under section 51 may be made was extended under section 53, there was no undue delay in making the request; or
- (b) dismiss the request.

(2) An order under this section must contain, or be subject to, the provisions prescribed for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the design between the date when the application became abandoned and the date on which the request is published under section 51.

(3) The Commissioner must publish in the Gazette the making of an order under subsection (1) after that order is made.

Offences in respect of designs required to be kept secret

56.—(1) Any person who fails to comply with any direction given under section 11, or who makes or causes to be made an application for the registration of a design in contravention of that section, commits an offence and is liable on conviction to a fine not exceeding \$1,000 or imprisonment for a term not exceeding 2 years or both.

(2) Where an offence against section 11 is committed by a body corporate, any person who at the time of the commission of the offence is a director, general manager, secretary or other similar officer of the body corporate, or is purporting to act in any such capacity, is deemed to have committed that offence unless he or she proves that the offence was committed by the body corporate without his or her consent or connivance and that he or she exercised all such diligence to prevent the commission of the offence by the body corporate as he or she ought to have exercised having regard to the nature of his or her functions in that capacity and to all the circumstances.

Falsification of register etc.

57. Any person who makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in that register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, commits an offence and is liable on conviction to imprisonment for a term not exceeding 2 years.

Fine for falsely representing a design as registered

58.—(1) Any person who falsely represents that a design applied to any article sold by him or her is registered in Fiji in respect of that article commits an offence and is liable on conviction to a fine not exceeding \$40.

(2) For the purposes of subsection (1), a person who sells an article having stamped, engraved, or impressed on or otherwise applied the words “registered in Fiji” or any other words expressing or implying that the design applied to the article is registered in Fiji is deemed to represent that the design applied to the article is registered in respect of that article.

(3) Any person who after the registration of a design has expired, marks any article to which the design has been applied with the words “registered in Fiji” or any word or words implying that there is a subsisting right in the registered design in Fiji or causes any such article to be so marked commits an offence and is liable on conviction to a fine not exceeding \$40.

PART 9—MISCELLANEOUS

Regulations

59.—(1) The Minister may make regulations to prescribe matters that are required or permitted by this Act to be prescribed or are necessary or convenient to be prescribed for carrying out or giving effect to this Act and generally for achieving the purposes of this Act including—

- (a) regulating the business of the Fiji Intellectual Property Office in relation to designs;

- (b) regulating all matters by this Act placed under the direction or control of the Commissioner;
 - (c) prescribing the form of applications for registration of designs and any representations or specimens of designs or other documents which may be filed with the Commissioner, and for requiring copies to be furnished of any such representations, specimens, or documents;
 - (d) prescribing the manner in which applications may be made under section 14(2);
 - (e) regulating the procedure to be followed in connection with a request to the Commissioner under sections 46 to 51, including providing for when and how requests must be made, the period for giving notice of opposition, penalties payable under section 51 and the matters referred to in section 51(2)(b);
 - (f) regulating the procedure to be followed in connection with a request to the Commissioner under sections 52 to 55, including providing for when and how requests must be made, the period for giving notice of opposition, and the matters referred to in section 55(2);
 - (g) regulating the procedure to be followed in connection with any application or request to the Commissioner or in connection with any proceeding before the Commissioner and for authorising the correction of irregularities of procedure;
 - (h) regulating the keeping of the register;
 - (i) regulating the manner in which the Commissioner may alter information in the register under section 32, including prescribing procedures, requirements and other matters in respect of an alteration;
 - (j) authorising the publication and sale of copies of representations of designs and other documents in the Fiji Intellectual Property Office;
 - (k) prescribing classes of persons whom the Commissioner may refuse to recognise as agents in respect of proceedings under this Act;
 - (l) prescribing matters to be published in the Gazette;
 - (m) prescribing fees in respect of the registration of designs and applications and in respect of other matters relating to designs arising under this Act;
 - (n) prescribing anything authorised or required by this Act to be prescribed by regulations.
- (2) The Minister may make regulations for all or any of the following purposes—
- (a) for the protection of persons who at any time in good faith have begun to avail themselves of any design that is the subject matter of a matter in respect of which any application under section 40 is made;

- (b) prescribing the evidence that the Commissioner may accept in support of applications under section 40;
- (c) protection of persons who at any time in good faith have begun to avail themselves of any design that is the subject matter of a matter in respect of which any application under section 40;
- (d) prescribing the manner of publication in the Gazette extensions of time granted under section 40;
- (e) prescribing the grounds of opposition to applications under section 40;
- (f) regulating the procedure to be followed in relation to applications under section 40 and opposition to such applications;
- (g) prescribing the fees to be paid in respect of applications under this section.

(3) Regulations made under this Act may provide for excluding from registration under this Act designs for such articles, being articles which are primarily literary or artistic in character, as may be specified in the regulations.

(4) Regulations may be made under this Act for securing that the representation or specimen of a design in the case of which directions are given under section 11 must not be open to inspection by the public during the continuance in force of the directions.

(5) The structure of the fee system under this Act prescribed by regulations under this section may be such that any fees for an extension of the period of registration of a design under section 14(2)—

- (a) recover a share of the costs incurred by the Commissioner in performing his or her functions under this Act; and
- (b) recover those costs at a level that provides an appropriate incentive for persons to not extend that period of registration of a design if they do not receive sufficient benefit from having the right in the registered design.

(6) The Commissioner may refund any sum paid to the Commissioner by mistake or any sum the payment of which is not required by the regulations made under this Act and all moneys so refunded must be paid out of public money without further appropriation than this Act.

Service of notices

60.—(1) A notice, an application, or any other document may be given to, made to, or filed with a person by—

- (a) sending it by post addressed to the person at the person’s usual or last known address; or
- (b) e-mailing it to the person at an e-mail address that is used by the person.

(2) A notice posted to a person by the Commissioner must be treated as received by the person when it would have been delivered in the ordinary course of post.

(3) In the absence of proof to the contrary, a notice e-mailed to a person by the Commissioner must be treated as received by the person on the second working day after the date on which it is e-mailed, and, in proving that the notice was e-mailed, it is sufficient to prove that it was properly addressed and sent to the e-mail address.

Designs contrary to law or morality

61. Nothing in this Act is to be construed as authorising or requiring the Commissioner to register a design the use of which would, in his or her opinion, be contrary to law or morality.

Repeal

62. The United Kingdom Designs (Protection) Act 1936 is repealed.

November 2020

DESIGNS BILL 2020

EXPLANATORY NOTE

(This note is not part of the Bill and is intended only to indicate its general effect)

1.0 BACKGROUND

- 1.1 The United Kingdom Designs (Protection) Act 1936 is currently the only law in Fiji that governs the registration and use of designs with respect to designs registered in the United Kingdom under the Patents and Designs Acts 1907 to 1932 ('**UK laws**') as imperial laws to Fiji.
- 1.2 The United Kingdom Designs (Protection) Act 1936 provides *inter alia* that a registered owner of a design under the respective UK laws enjoys the same rights and privileges as though the certificate of registration in the United Kingdom had been issued with an extension to Fiji.
- 1.3 The United Kingdom Designs (Protection) Act 1936 however does not provide for the registration of designs in Fiji nor does it provide an avenue for the protection of designs made by Fijians.
- 1.4 Accordingly, the Designs Bill 2020 ('**Bill**') seeks to provide for the registration and protection of designs in Fiji and makes provision for international arrangements that Fiji may be a party to for the protection of registered designs in Fiji, that may be used in other countries and vice-versa.

2.0 CLAUSES

- 2.1 Clause 1 of the Bill provides for the short title and commencement. If passed by Parliament, the Act will come into force on a date or dates appointed by the Minister by notice in the Gazette.
- 2.2 Clause 2 of the Bill provides for the definitions of the terms used throughout the Bill.
- 2.3 Clause 3 of the Bill states that the State is bound by the provisions of the new legislation.

- 2.4 Clause 4 of the Bill provides that the Solicitor-General will perform the function and exercise the powers of the Commissioner of Designs (**‘Commissioner’**).
- 2.5 Clause 5 of the Bill allows the Commissioner to delegate his or her functions, duties or powers to any person, except the power of delegation.
- 2.6 Clause 6 of the Bill affords indemnity to the Commissioner or any other person acting on behalf of the Commissioner for any act done or omitted to be done in the performance or intended performance of the Commissioner’s functions or duties, or the exercise or intended exercise of the Commissioner’s powers if the Commissioner or other person acted in good faith, in a reasonable manner and in the reasonably held belief that the prerequisites for the performance of any function or duty or the exercise of any power had been satisfied.
- 2.7 Clause 7 of the Bill specifies the designs that are registrable. Subject to the other provisions of the Bill, a design must be new or original in order for it to be registered. A design may, on an application made by the person claiming to be the owner, be registered in respect of any article or set of articles specified in the application.
- 2.8 Clause 8 of the Bill deals with ownership of designs. The author of a design must be treated as the owner of the design (**‘owner’**). If the design is executed by the author for another person for good consideration, the other person must be treated as the owner. If the design (or the right to apply a design to an article) is vested in another person by assignment, transmission or operation of law (either solely or jointly), the person (if solely) or the owner and other person (if jointly) must be treated as the owner.
- 2.9 Clause 9 of the Bill provides the process for registration. An application for the registration of a design (**‘application’**) must be made and filed with the Commissioner in the prescribed form and manner. In determining whether a design is new or original, the Commissioner may conduct necessary searches. The Commissioner may then register the design or refuse the application. Clause 9 of the Bill also provides that where an applicant has defaulted or neglected the completion of an application to register a design within the prescribed time the application is deemed to be abandoned. A design when registered must be registered as of the date on which the application was made.
- 2.10 Clause 10 of the Bill provides that where the registered owner of a design registered in respect of any article makes an application for registration:
- (i) in respect of one or more other articles, of the registered design; or
 - (ii) in respect of the same or one or more other articles, of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially affect the identity of the registered design,

the application must not be refused and the registration made on that application must not be invalidated by reason only of the previous registration or publication of the registered design. Clause 10 of the Bill also states that where any person makes an application for the registration of a design in respect of any article and either:

- (i) that design has been previously registered by another person in respect of some other article; or
- (ii) the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity of the registered design,

then, if at any time while the application is pending the applicant becomes the registered owner of the design previously registered, the previous rule applies as if at the time of making the application the applicant had been the registered owner of that design.

- 2.11 Clause 11 of the Bill ensures secrecy in respect of designs relevant for defence purposes.
- 2.12 Clause 12 of the Bill provides for confidential disclosure.
- 2.13 Clause 13 of the Bill states that the registration of a design gives to the registered owner the exclusive right in the registered design in Fiji to make, import for sale or use for the purposes of any trade, or to sell, hire or offer for sale or hire any article in respect of which the design is registered.
- 2.14 Clause 14 of the Bill provides the period of right in the registered design which subsists for a period of 5 years from the date of registration and may be extended upon application for a second period of 5 years from expiration of the original period.
- 2.15 Clause 15 of the Bill affords exemption from liability to an innocent infringer, that is, where the infringer was not aware and had no reasonable ground at the date of the infringement for believing that the design was registered in Fiji.
- 2.16 Clause 16 of the Bill allows an interested person to, after a design has been registered, apply to the Commissioner for a compulsory licence in respect of the design on the ground that the design is not applied in Fiji by any industrial process or means to the article in respect of which it is registered to a reasonable extent.
- 2.17 Clause 17 of the Bill allows the Commissioner to cancel the registration of a design upon request of the registered owner.

- 2.18 Clause 18 of the Bill allows any Government department and any person authorised in writing by a Government department to use any registered design for the services of the State.
- 2.19 Clause 19 of the Bill provides the rights of third parties in respect of State use of a registered design.
- 2.20 Clause 20 of the Bill deals with reference of disputes as to State use of a design for services of the State which may be referred to the court by either party to the dispute.
- 2.21 Clause 21 of the Bill deals with State use of a design during emergency for any purpose which appears to the Government to be necessary or expedient to *inter alia* ensure that whole resources of the community are available for use.
- 2.22 Clauses 22 to 26 of the Bill deal with international arrangements to which Fiji is a party for the purposes of registration of a design and where protection of the design is afforded.
- 2.23 Clause 27 of the Bill states that the Commissioner must ensure that a register of designs registered in Fiji is kept and maintained (**‘register’**).
- 2.24 Clause 28 of the Bill states that the Commissioner must grant a certificate of registration to the registered owner of a design when the design is registered.
- 2.25 Clause 29 of the Bill deals with the registration of a person who becomes entitled by assignment, transmission or operation of law to a registered design or share thereof.
- 2.26 Clause 30 of the Bill states that the Personal Property Securities Act 2017 is not affected by the provisions of clauses 26 to 28.
- 2.27 Clause 31 of the Bill allows the court to correct the register.
- 2.28 Clause 32 of the Bill allows the Commissioner to correct a mistake on the register or in any document as a result of the Commissioner’s error or omission. The Commissioner may also require the production of the document.
- 2.29 Clause 33 of the Bill requires the representation or specimen of a registered design to be open for public inspection on and after the day on which the certificate of registration is issued. Where a design is registered in respect of an article of a prescribed class, any representation or specimen of the design filed must not be open for public inspection until the specified period after the day on which the certificate of registration is issued has expired except by the registered owner, person authorised in writing by the registered owner or a person authorised by the Commissioner or the court.

- 2.30 Clause 33 of the Bill also provides that where the Commissioner proposes to refuse an application because it is the same or differs slightly from a prior design, the applicant in this instance is entitled to inspect the representation or specimen of the first design. Furthermore, where an application has been abandoned or refused, the application for registration as well as the representation or specimen of the design filed must not be open for public inspection or publication.
- 2.31 Clause 34 of the Bill provides that the Commissioner must inform a person as to whether a design is registered and any articles associated, name and address of the registered owner if the person has made a request, provided information to the Commissioner to identify the design and paid the prescribed fee.
- 2.32 Clause 35 of the Bill provides that a certificate indicating or showing out to be signed by the Commissioner certifying that an entry has been made or has not been made is *prima facie* evidence of the entry or non-entry. The same applies to a copy of or an extract from, any entry in the register or document registered or kept by the Commissioner, and is admissible evidence in legal proceedings.
- 2.33 Clause 36 of the Bill provides that the court may certify that the validity of the registration of a design was contested in any proceedings in instances where the validity of registration of a design was questioned and found to be valid. If, in any subsequent proceedings on the infringement of the right in the registered design or cancellation of the registration of the design, the court gives a final order in favour of the registered owner, he or she is entitled to solicitor's costs.
- 2.34 Clause 37 of the Bill allows a person who is aggrieved by threats of proceedings for infringement of the right in a registered design to bring an action against the person making such threats and is entitled to claim for relief such as a declaration that the threats are unjustifiable, an injunction against the continuance of such threats and damages.
- 2.35 Clause 38 of the Bill provides that an appeal made under the Bill against a decision of the Commissioner must be made to the court and a notice of appeal must be filed in court and served on the Commissioner within 28 days after the day on which the decision in question was given. Consequently, no appeals from a decision of the court may be made except with the leave of the court or Court of Appeal.
- 2.36 Clause 39 of the Bill requires the Commissioner to give an applicant for registration of a design an opportunity to be heard before making a decision in the exercise of the Commissioner's power of discretion under the Bill.
- 2.37 Clause 40 of the Bill provides that where a delay has been caused by the Commissioner for something required under the Bill within a prescribed time, the Commissioner may extend the time needed to carry out or do that which needed to be done. Furthermore, clause 40 of the Bill provides that no fees are payable in this instance.

- 2.38 Clause 41 of the Bill further allows the Commissioner to extend the time prescribed for the filing of an application under clause 22(1) of the Bill in relation to an application for the registration of a design, the protection of which has been applied for in a convention country. The Commissioner however may also refuse to grant an extension in this instance if he or she is of the opinion that the applicant or applicant's agent has not allowed enough time for the delivery of any document relating to the application for an extension of time or failed to act with due diligence and prudence, or there has been undue delay in applying for an extension of time or prosecuting the application.
- 2.39 Clause 41 of the Bill also allows the Commissioner to grant the extension of time applied for by an agent provided written confirmation of the agent's authority to act on behalf of an applicant is signed and lodged with the Commissioner. An application for the extension of time must be made before the registration of the design.
- 2.40 Clause 42 of the Bill allows the Commissioner to award to any party in any proceedings before the Commissioner, costs as he or she thinks reasonable and direct how and by what parties such costs are to be paid. Where an application is made for the cancellation of the registration of a design, grant of a licence in relation to a registered design or a notice of appeal is given from a decision of the Commissioner by an applicant who does not reside in Fiji, the Commissioner or the court may require him or her to give security for costs of the proceedings or the appeal. If this is not done, the application or appeal would be treated as abandoned.
- 2.41 Clause 43 of the Bill allows evidence in proceedings under the Bill to be given by way of an affidavit or statutory declaration and gives discretion to the Commissioner to also take oral evidence and allow witnesses to be cross-examined on their affidavit or statutory declaration. The use of a statutory declaration may also be used as evidence in an appeal under the Bill.
- 2.42 Clause 44 of the Bill recognises agents duly authorised in the prescribed manner to carry out an act in relation to a registered design or proposed registered design or any proceedings as required under the Bill.
- 2.43 Clause 45 of the Bill allows the Commissioner to dispense with the production of probate or letters of administration and register any qualified person, defined as the owner of a design where the registered owner has died, or allow any qualified person to complete an application and register himself or herself as the owner of the design where the applicant dies before the registration of the design.

- 2.44 Clause 46 of the Bill allows the restoration of lapsed registration of a design due to failure to make an application for an extension of registration of a design or failure to pay for the prescribed fee, or both. An extension granted under this clause may be for a second period of 5 years at the Commissioner's discretion on whether failure to apply for an extension was unintentional.
- 2.45 Clause 47 of the Bill allows a registered owner or where the registered owner is deceased, his or her personal representative, to request for an order under clause 46 of the Bill for the restoration of lapsed registration of a design. Clause 47 of the Bill further allows for 2 or more registered owners to make a request for the order provided they have leave of the Commissioner to make such a request either by one or more of them without joining the other registered owners. However such request may only be made within the prescribed period which may be extended by the Commissioner if satisfied that there was no undue delay in making the request. This is provided for under clause 48 of the Bill.
- 2.46 Clause 49 of the Bill provides that on consideration of a request under clauses 46 to 48 of the Bill, the Commissioner must give the person making the request an opportunity to be heard if the Commissioner is not satisfied that a prima facie case has been made under clause 46 of the Bill or must publish in the Gazette if satisfied otherwise.
- 2.47 Clause 50 of the Bill allows a person who wishes to oppose an order made under clause 46 of the Bill to give notice of opposition to the Commissioner with the prescribed period. The Commissioner must then notify the person who made the request and provide a copy of the notice provided, and give both the person opposing the order and the person who made the request, an opportunity to be heard.
- 2.48 Clause 51 of the Bill requires the Commissioner to make an order on payment of any unpaid fees and any penalties. Clause 51 of the Bill also provides the conditions on which an order for the extension of registration of a design may be made and requires the Commissioner to give the registered owner an opportunity to be heard before deciding to revoke any such order.
- 2.49 Clause 52 of the Bill provides that where an application for registration is abandoned, an applicant may request that an order be made to restore the application and to extend the period for complying with the requirements for making an application. This is also provided for under clause 53 of the Bill which requires such the applicant to provide a statement setting out the circumstances that caused and reasons for, the delay.
- 2.50 Clause 52 of the Bill also provides that the Commissioner must then give the person making the request an opportunity to be heard if the Commissioner is not satisfied that the default or negligence of the applicant was unintentional. If the Commissioner is satisfied, he or she must publish the request in the Gazette.

- 2.51 Clause 54 of the Bill allows a person to give notice to the Commissioner of opposition to an order made under clause 56 of the Bill on the grounds the default or neglect of the applicant was intentional or that the delay in making a request under clause 53 of the Bill was undue. The Commissioner must then notify the applicant of the notice of opposition and provide a copy of the notice to him or her. The Commissioner must also give both the applicant and the person opposing the order an opportunity to be heard.
- 2.52 Clause 55 of the Bill requires the Commissioner to make a decision after the expiry of the prescribed period for giving notice of opposition under clause 54 of the Bill or dismiss the request made. An order made under this clause is however subject to provisions for protection or compensation of persons who availed themselves of the design between the date the application became abandoned or on which the request was published.
- 2.53 Clause 56 of the Bill provides that it is an offence to fail to comply with any direction given under clause 11 of the Bill or to make or cause to be made an application for the registration of a design in contravention of clause 11 of the Bill. Any person who commits this offence is liable on conviction to a maximum fine of \$1000 or maximum imprisonment term of 2 years or both fine and imprisonment. Where a body corporate has committed the offence, clause 56 of the Bill also holds the director, general manager or other similar officer of the body corporate liable for the offence unless proven *inter alia* that the offence was committed without his or her consent.
- 2.54 Clause 57 of the Bill provides that it is an offence to make or cause to make a false entry in the register or a writing falsely purporting to be a copy of an entry in that register or produce false evidence which renders a person liable on conviction to a maximum imprisonment term of 2 years.
- 2.55 Clause 58 of the Bill provides that it is an offence for a person to falsely represent that a design applied to any article sold by him or her, is registered in Fiji. Clause 58 of the Bill also provides that it is an offence to mark any article to which a registered design has been applied as being registered in Fiji after the registration of a design has expired. A person who commits either of the offences in clause 58 of the Bill is liable on conviction to a maximum fine of \$40.
- 2.56 Clause 59 of the Bill empowers the Minister to make regulations to give effect to the provisions of the Bill and prescribe matters that are required or permitted by the Bill to be so prescribed, and to achieve the general purpose of the Bill. Clause 58 of the Bill also includes a list of what matters may specifically be prescribed by regulations.

- 2.57 Clause 60 of the Bill provides the ways in which a notice or any other document can be served under the Bill. Clause 60 of the Bill further provides that service by post must be treated as received by the recipient when it would be delivered in the ordinary course of post and service by e-mail must be treated as received by the recipient on the second working day after the date it is emailed.
- 2.58 Clause 61 of the Bill prohibits anything from being construed as giving authority or requiring the Commissioner to register a design if it is contrary to law or morality in the Commissioner's opinion.
- 2.59 Clause 62 of the Bill repeals the United Kingdom Designs (Protection) Act 1936.

3.0 MINISTERIAL RESPONSIBILITY

- 3.1 The Act comes under the responsibility of the Minister responsible for designs.

A. SAYED-KHAIYUM
Attorney-General